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Paper No. 10

DENNISON ASSOCIATES  
133 RICHMOND STREET WEST  
SUITE 301  
TORONTO ON M5H 2L7  
CANADA

**MAILED**  
**NOV 30 2010**  
**OFFICE OF PETITIONS**

In re Patent No. 6,648,330 :  
Issue Date: 11/18/2003 :  
Application Number: 10/071,093 : DECISION ON PETITION  
Filing Date: 02/11/2002 :  
Attorney Docket Number: JJ-11 :  
028US :

This is a decision on the petition filed on September 10, 2010, under 37 CFR § 1.378(b) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued November 18, 2003. The first maintenance fee could have been paid from November 18, 2006, through May 18, 2007, or, with a surcharge during the period from May 19 through November 18, 2007. Accordingly, the patent expired at midnight

on November 18, 2007, for failure to timely submit the maintenance fee.

Petitioner, patentee Michael Porter, asserts, in pertinent part:

In late March, 2007, Petitioner received a letter from Dennison Associates regarding the payment of the maintenance fee for the U.S. Patent. In April, 2007, Petitioner met with Mr. John Jeffrey of Dennison Associates, Petitioner's agent, and advised him that due to a shortage of funds, Petitioner would be unable to pay the maintenance fee. At that time, Petitioner also misunderstood the maintenance fee requirements for U.S. Patents and assumed that this maintenance fee would be an annual fee similar to the Canadian Patent. Subsequent to that meeting, Petitioner moved from the Brunswick Street address and further correspondence from Mr. Jeffrey was returned. A copy of this correspondence and returned envelope is attached. As Petitioner did not have any telephone service at that time or subsequent, Mr. Jeffrey was unable to correspondence further with Petitioner.

In March, 2010, Petitioner contacted Mr. Jeffrey in an attempt to sell or license the patent and was informed by Mr. Jeffrey that the patent had expired for non-payment of the maintenance fee. Petitioner was also advised of the procedure to petition for reinstatement and the costs associated with the petition. At that time, Petitioner did not have the funds available to go forward with the request and was only able to raise them in late July, 2010. Since that time Petitioner has taken the steps to promptly file this petition.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks requirement (1).

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".<sup>1</sup>

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").<sup>2</sup> Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.<sup>3</sup> In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>4</sup>

A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner

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<sup>1</sup> 35 U.S.C. § 41(c)(1).

<sup>2</sup> Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

<sup>3</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

<sup>4</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

"exercised the due care of a reasonably prudent person."<sup>5</sup> This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>6</sup> Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.<sup>7</sup> Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.<sup>8</sup> However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.<sup>9</sup> In view of In re Patent No. 4,409,763, this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.<sup>10</sup> That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.<sup>11</sup>

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<sup>5</sup> Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

<sup>6</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>7</sup> In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

<sup>8</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>9</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

<sup>10</sup> Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

<sup>11</sup> Id.

Petitioner has not presented a sufficient showing of unavoidable delay resulting from financial hardship. A complete showing is required of petitioner's, or the party responsible for payment of the maintenance fee's, financial condition including all income, expense, assets, credit, and obligations which made the delay from November 18, 2007, the date the maintenance fee was due, until the filing of a grantable petition including the maintenance fee unavoidable. Petitioner must provide verified copies of any available documents or records (e.g. copies of all bank statements and income tax returns) covering the entire period between November 18, 2007, and the filing of a grantable petition, including the maintenance fee payment.

Petitioner has not provided a detailed explanation of his income and assets during the period that payment of the maintenance fee was delayed (i.e., from November 18, 2007, to the submission of a grantable petition including payment of the maintenance fee).

Likewise, petitioner should explain whether he had sufficient credit available to charge the maintenance fee during the period when it could have been timely paid. Petitioner should also explain whether any other sources of income, such as loans or gifts, were available that could have been used to timely pay the maintenance fee.

If petitioner chooses to file a detailed showing as stated above, petitioner may wish to consider redacting any confidential identity information (including, but not limited to social security numbers, bank account or credit card numbers, or sensitive medical information). Any information submitted will become part of the official record.

Further, with regard to petitioner's assertion that he "misunderstood the maintenance fee requirements for U.S. Patents", a delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.<sup>12</sup>

Lastly, with regard to petitioner's assertion that his patent practitioner was unable to contact him, a delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay.<sup>13</sup>

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<sup>12</sup> See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

<sup>13</sup> In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (571) 273-8300  
                  Attn: Office of Petitions

By hand:          Customer Service Window  
                  Mail Stop Petition  
                  Randolph Building  
                  401 Dulany Street  
                  Alexandria, VA 22314

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Telephone inquiries should be directed to the undersigned at 571-272-3231.

A handwritten signature in cursive script, appearing to read "D. Wood".

Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions